

REMARKS/ARGUMENTS

These remarks are made in response to the final Office Action of November 10, 2008 (Office Action). As this response is timely filed within the 3-month shortened statutory period, no fee is believed due. However, the Examiner is expressly authorized to charge any deficiencies to Deposit Account No. 50-0951.

Claim Rejections – 35 USC § 103

Claims 1-8 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Published Patent Application No. 2003/0225600 to Slivka, *et al.* (hereinafter Slivka) in view of U.S. Published Patent Application 2008/0270222 to Goel (hereinafter Goel). Applicants respectfully disagree with the rejections and thus have not amended the claims to overcome the art rejections.

Applicants believe that it would not have been obvious to combine the teachings of Slivka and Goel to disclose presenting the determined at least one rebooking flight candidate to said passenger *with an incentive for encouraging the passenger to select a rebooking flight candidate preferred by the carrier.* The Office Action directs Applicants to paragraph [0028] of Slivka for its monitor and paragraphs [0038] and [0177-0179] of Goel for its rebook options, however neither Slivka nor Goel disclose presenting a rebooking flight candidate with an incentive for encouraging the passenger to select a rebooking flight candidate. In fact, no where is there any mention of incentives in any of the cited portions of Slivka and Goel, let alone incentives being used for encouraging passengers to select a rebooking flight candidate preferred by the carrier.

The Office Action also asserts that since Slivka discloses a personal computer and a monitor in paragraph [0019] that this implies travel accommodations are selected from the personal computer by a passenger. Applicants respectfully disagree and note that

Slivka does not mention anywhere that a user selects rebooking flight candidates from a computer. The established case law of inherency provides the following:

The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993) (reversed rejection because inherency was based on what would result due to optimization of conditions, not what was necessarily present in the prior art); *In re Oelrich*, 666 F.2d 578, 581-82, 212 USPQ 323, 326 (CCPA 1981). "To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.' " *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) (citations omitted) (The claims were drawn to a disposable diaper having three fastening elements. The reference disclosed two fastening elements that could perform the same function as the three fastening elements in the claims. The court construed the claims to require three separate elements and held that the reference did not disclose a separate third fastening element, either expressly or inherently.).

"In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original).

Chapter 2112.IV., Manual of Patent Examination Procedure (emphasis added).

The rejections, which cite to paragraph [0019] and FIG. 1 of Slivka, would require speculation or establishing probabilities or possibilities to find that Slivka teaches accommodations being selected from a personal computer by a passenger. Furthermore, there is no basis in fact that Applicants' feature of passengers selecting rebooking flight candidates necessarily flows from the mere fact of having a computer and monitor. For

example, a computer and a monitor might only be used for displaying information rather than the extra feature of allowing passengers to select rebooking flight candidates.

Accordingly, as a result of the deficiencies of both Slivka and Goel, Slivka and Goel, alone or in combination, fail to teach or suggest every feature recited in independent Claim 1. Additionally, it would not have been obvious to one of ordinary skill in the art to include the features in Applicants' invention based upon Slivka and Goel. Applicants respectfully submit, therefore, that independent Claim 1 defines over the prior art. Applicants further respectfully submit that, since claims 2-8 depend from Claim 1, these dependent claims likewise define over the prior art. Moreover, Applicants believe that all the rejections are moot because Applicants' invention predates Goel, as discussed below.

Applicants' Invention Predates Goel

Applicants believe that any rejections are moot because Applicants' invention predates the earliest effective date of October 24, 2003 of Goel.

Applicants of the present invention conceived their invention at least as early as February 18, 2003 and actively pursued its reduction to practice from a date prior to the effective date of Goel. In support of their assertions of conception, diligence, and constructive reduction to practice, Applicants submit the Declarations of Applicants Bramnick, Farnum, and Burch attached hereto in accordance with 37 CFR § 1.131 along with other supporting evidence of Applicants' diligence in pursuing the present Application. The Declarations provide the sworn testimony of Applicants affirming their conception and continuing diligence from a time prior to the effective date of Goel to the filing of the instant Application.

Along with these Declarations, Applicants also submit herewith a copy of a confidential invention disclosure, No. BOC8-2003-0035, titled "A Method to

Reaccommodate Airline Passengers on an Individualized Basis via a Self Service Device," authored by Applicant Bramnick (hereinafter Disclosure). The Disclosure was submitted on February 19, 2003 to a Patent Attorney/Intellectual Property (IP) Professional employed by the assignee of the present invention, International Business Machines Corporation (IBM).

The Disclosure explicitly describes the present invention. The written description provided in the Disclosure is clear evidence of the Applicants' conception of the claimed subject matter at least as early as February 18, 2003.

The Disclosure is an IBM confidential disclosure form. As such, it is a standardized document that, according to established IBM procedures, is used by IBM inventors to document the conception of an invention. Strictly-followed internal procedures established by IBM govern the use of all such confidential disclosure forms. One aspect of IBM's established procedures governing the use of such confidential disclosure forms is that no substantive modifications can be made to a confidential disclosure after it has been submitted to an IBM Patent Attorney/IP Professional.

Applicants exercised due diligence from prior to the effective dates of Goel to the date that the Application was filed. As expressly affirmed in the Declarations, Applicants, from at least the effective dates of Goel, through the filing of the Application on December 9, 2003, worked diligently toward a constructive reduction to practice of the invention. Applicants initially worked with IBM's own in-house Patent Attorneys/IP professionals during an internal review of the invention, including assessing the invention in the context of related literature. Subsequently, Applicants worked with Patent Attorneys retained by IBM (outside counsel) to prepare and file the Application.

Outside counsel prepared the Application consistent with long-established professional practices, according to which cases are prepared on a first-in, first-out basis unless a particular application is associated with a bar date; those applications associated

with bar dates are granted priority within the work queue. Outside counsel followed this professionally-accepted practice in preparing the Application in this case.

The written description and each of the claims of the Application were prepared based upon the Applicants' attached Disclosure. Moreover, according to IBM's established procedures governing the use of such disclosures and Applicants' sworn testimony in the Declarations, the Applicants reviewed the Application prior to its submission to the U.S. Patent and Trademark Office in order to ensure that the claims and written description contained therein were fully supported by the Disclosure.

The following documentary evidence is submitted herewith showing Applicants' due diligence:

- Exhibit A is a letter from an IBM Patent Attorney requesting outside counsel prepare the Application, dated April 29, 2003.
- Exhibit B is a letter from outside counsel confirming receipt of the instructions, dated May 7, 2003.
- Exhibit C is an email letter, dated November 28, 2003, from outside counsel requesting review and approval of the draft Application by the Applicants.
- Exhibit D is a series of email letters, the last of which is dated December 1, 2003, from Applicants to outside counsel, approving the draft Application with some minor changes.
- Exhibit E is an email letter, dated December 2, 2003, from outside counsel requesting review and final approval of the Application, together with Declaration and Power of Attorney and Assignment for Applicants to sign.

- Exhibit F is a copy of the Declaration and Power of Attorney and Assignment signed by the Applicants and filed with the Application on December 9, 2003, evidencing Applicants' approval of the application.

Applicants respectfully submit that it was reasonable for them and the Assignee of their invention, IBM, to rely on outside counsel in preparing the Application, and that outside counsel acted with diligence. Applicants and outside counsel operated under the constraints of other work obligations while preparing the Application. As noted in MPEP § 2138.06, inventors and their patent attorneys are never required to drop all other work to deal with an issue in a patent application. Applicants therefore submit that Applicants and their Patent Attorneys diligently pursued completion and filing of the present application without any unreasonable delays.

Accordingly, Applicants respectfully submit that Applicants' Declarations, coupled with the documentary evidence of specific activity on specific dates, clearly evidences Applicants' prior conception and diligence in pursuing an actual and constructive reduction to practice from a time prior to the effective dates of Goel. Applicants therefore respectfully request withdrawal of all rejections in connection with Goel.

Appln No. 10/730,851
Amendment dated December 22, 2008
Reply to Office Action of November 10, 2008
Docket No. BOC9-2003-0038 (407)

CONCLUSION

Applicants believe that this application is now in full condition for allowance, which action is respectfully requested. Applicants request that the Examiner call the undersigned if clarification is needed on any matter within this Amendment, or if the Examiner believes a telephone interview would expedite the prosecution of the subject application to completion.

Respectfully submitted,

AKERMAN SENTERFITT

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/Gregory A. Nelson/
Gregory A. Nelson, Registration No. 30,577
Customer No. 40987
Post Office Box 3188
West Palm Beach, FL 33402-3188
Telephone: (561) 653-5000